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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,459	11/28/2000	Gopinathan K. Menon	680.0041USU	6235

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 04/23/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Applicati n No.

09/723,459

Applicant(s)

MENON ET AL.

Examin r

Clinton Ostrup

Art Unit

1614

-- The MAILING DATE f this communicati n appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-13,15-21 and 29-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13,15-21 and 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 10-13, 15-21 and 29-38 are pending in this application.

#### ***Claim Objections***

Claims 13, 17, and 35 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 13, 17, and 35 claim the crape myrtle extract, or the composition comprising crape myrtle extract, being applied to the skin daily for a period of time sufficient to improve the aesthetic appearance of skin, however, the independent claims from which claims 13, 17, and 35 depend have already described applying the composition to the skin. Thus, claims 13, 17 and 35 read on one single application, which would encompass one daily application; therefore, the independent claims encompass such an application process. This objection can be made moot by specifying the length of time that the composition is applied to the skin.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1614

Claim 16 recites the limitation "the effects of skin aging," however, there is insufficient antecedent basis for this limitation in the claim. There is sufficient antecedent basis for "the effects of extrinsic and/or intrinsic aging on skin."

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13, 15-21, and 31-38 are rejected under 35 U.S.C. 102(b) as being anticipated by MIKIMOTO PHARMACEUTICAL, CO, LTD., JP 07-126143, herein referred to as 07-126143.

The 07-126143 reference describes a cosmetic for whitening the skin, which contains an extract of *Lagerstroemia speciosa*. The 07-126143 reference teaches using the extract to prepare conventional cosmetics such as lotions, creams, emulsions, and packs using known additives and carriers. Claim 8 would be inherently met by the reference, because colosolic acid is in the extract of *Lagerstroemia speciosa*.

The 07-126143 reference teaches using a composition comprising *Lagerstroemia speciosa* for skin whitening, preventing skin roughness, skin glossiness, and skin tension. The 07-126143 reference teaches amounts of *Lagerstroemia speciosa* extract that overlap those as claimed instantly in claims 11-12 and 20. The 07-126143 reference teaches that water content is held in intercellular space because of hyaluronic acid and that hyaluronic acid is reduced with age and wrinkles and rough skin are the result of hyaluronic acid reduction.

Art Unit: 1614

The 07-126143 reference teaches that the extract of *Lagerstroemia speciosa* inhibits the enzyme hyaluronidase, the enzyme that breaks down hyaluronic acid, thereby preventing rough skin. See: page 3-23.

Claims 10, 13, 15-19, 30-35, and 38 rejected under 35 U.S.C. 102(b) as being anticipated by NIPPON KIKAKU KAIHATSU KK[[NIKJ], JP 05208913 A, herein referred to as NIPPON.

NIPPON teaches using an extract of *Lagerstroemia indica* (crape myrtle) to soften the stratum corneum (horny layer) of skin. Since the application of the extract and the subsequent removal of the stratum corneum would inherently improve the aesthetic appearance of skin by promoting/accelerating cell turnover, improving skin tone, restoring skin luster, and minimizing signs of fatigue, the NIPPON reference clearly anticipates instant claims 10, 13, 30-35. Furthermore, the method of removing the stratum corneum as taught by NIPPON would inherently treat and/or ameliorate the effects of extrinsic and/or intrinsic aging on skin such as removing fatigued skin and dry skin, thus, meeting the specific limitations of instant claims 15-19 and 38. See: abstract.

This is an anticipation rejection because the outermost layer is the stratum corneum (horny layer) composed of flattened dead cells that act as a barrier against light and heat energy and protect the body from water loss, microorganisms, and many chemical and by removal of this horny layer, the stratum germinativum (regenerative layer), generates new cells that give rise to all other cell layers in the epidermis.

Art Unit: 1614

Claims 10, 13, 15-18, 32-35, and 38 rejected under 35 U.S.C. 102(b) as being anticipated by (MINI-N) MIKIMOTO SEIYAKU KK, JP 07157420, herein referred to MIMI-N.

MINI-N teaches a cosmetic material having skin whitening, anti-oxidation and hyaluronidase inhibition activities as well as good skin moisturizing effects. The composition is taught to contain Lagerstroemia speciosa and have good appearance.

Since moisturizing skin is associated with improved aesthetic skin appearance because it will improve skin tone, restore skin luster, and minimize signs of fatigue as well as treating lack-luster skin, fatigued skin, and especially dry skin, the reference would inherently meet instant claims 10, 13, and 15-18, 32-35 and 38. See: abstract.

The instant claims may use different terminology to describe the results obtained from the application a composition comprising crape myrtle extract, and a pharmaceutically acceptable carrier, to skin; however, the references above teach the same composition, applied to the same substrate, for the same reasons, (i.e. improving the aesthetic appearance of the skin). Therefore, the instantly claimed method steps of applying a composition comprising crape myrtle extract and a pharmaceutically acceptable carrier to the skin has been met by the references above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 00/16791 and WO 97/18823 are being provided because they teach myrtle extracts in cosmetic compositions.

Art Unit: 1614

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup  
Examiner  
Art Unit 1614



Frederick Krass  
Primary Examiner  
Art Unit 1614



April 17, 2003